

3/27/02

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Paper No. 14

PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Milano Hat Company, Inc.

Serial No. 75/199,511

Alan W. Lintel of Anderson, Levine & Lintel, L.L.P. for
Milano Hat Company, Inc.

Keith Weltsch, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Hairston, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by the Milano Hat
Company, Inc. to register the composite mark MILANO and
design, as shown below,

for "western wear, namely, shirts."¹

Registration has been refused under Sections 2(e)(3) and 2(a) of the Trademark Act on the grounds that the mark is geographically deceptively misdescriptive and geographically deceptive. It is the Examining Attorney's position that if applicant were to use the mark on the identified goods, purchasers would mistakenly believe that the goods originate in Milan, Italy, and that this misunderstanding would be a material factor in the purchasing decision.

Applicant has appealed. Briefs have been filed, but no oral hearing was requested.

The test for determining whether a mark is geographically deceptive under Section 2(a) is set forth in *Institut National des Appellations D'Origine v. Vintners International Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992). The test consists of three elements, the first two of which also comprise the test for determining whether a mark is geographically deceptively

¹ Serial No. 75/199,511 filed November 18, 1996, based on an allegation of a bona fide intention to use the mark in commerce. The pictorial representation of Italy has been disclaimed apart from the mark as shown.

misdescriptive under Section 2(e)(3). The elements are as follows:

1. Whether the primary significance of the mark as it is used is a generally known geographic place;
2. Whether purchasers are likely to believe, mistakenly, that the goods or services sold under applicant's mark have their origin in or are somehow connected with the geographic place named in the mark and, if so;
3. Whether a purchaser's mistaken belief as to the geographic origin of the goods or services would materially affect that purchaser's decision to buy the goods or services sold under the mark.

At the outset, we note that applicant is incorporated in the state of Texas and has indicated that its shirts will not be manufactured or produced in Milan, Italy. Further, there is no dispute that the term "Milano" is Italian for the city of Milan in Italy.²

² In this regard, the Examining Attorney submitted an entry from Webster's New Geographical Dictionary (1988), the relevant portion of which is reproduced below:

In urging reversal of the refusals to register, applicant argues that the primary significance of the term Milano is not geographic. Rather, applicant maintains that the primary significance of Milano is as a surname, and that applicant selected the applied-for mark because of the surname of its founder, John Milano, and not because of any desired connection with Milan. According to applicant, it is a company which is internationally known for its western hats, and, thus, prospective purchasers will associate the applied-for mark with applicant, the Milano Hat Company, and not the city of Milan.

Further, applicant maintains that western wear is indigenous to the United States, and that no appreciable amount of western wear has ever been designed or produced in Milan. According to applicant, the Examining Attorney has presented no evidence that any Milanese company has a favorable reputation as a western wear provider. Applicant maintains that while Milan may be well known for haute couture clothing, it is not known for the design or manufacture of western wear. Finally, applicant states that the star on the map of Italy in the drawing of its mark designates the city of Sorrento, which is located is located in the southern part of Italy, and is the birthplace of applicant's founder. Applicant maintains

that there will be no deception in this case because the star serves to negate any connection with Milan, which is located in the northernmost part of Italy.

Applicant offered the declaration of Clay Cavender, vice-president and head buyer of Cavender's Boot City, a chain of approximately forty western wear stores located throughout Texas. According to Mr. Cavender, Cavender's Boot City is one of the largest sellers of western wear products in the country. Mr. Cavender states that he is familiar with buyer preferences in relation to western wear and that he has purchased products from applicant for many years for sale in Cavender's Boot City stores. Further, Mr. Cavender states that to his knowledge, no customer has ever purchased or considered purchasing applicant's products sold under the same or similar mark involved herein under the impression that the products had a connection with Milan; that customers of western wear prefer that such goods come from a company based in the southwest United States rather than from a company in a "high fashion" center such as Milan, Paris, London or New York; and that no significant number of consumers of western wear has been or will be deceived with regard to any geographic connection to Milan by applicant's mark as used on western clothing.

It is the Examining Attorney's position that the primary significance of applicant's mark as a whole is the geographic place Milan, Italy. As noted previously, the Examining Attorney submitted a dictionary entry with regard to the term "Milano." The Examining Attorney acknowledges that the entire mark is more than the word MILANO. However, the Examining Attorney argues that the pictorial representation of Italy in the drawing of the mark reinforces the geographic connotation of the mark as a whole.

Further, in view of the evidence of a goods/place association between clothing and Milan, and the fame of Milan as a fashion center, the Examining Attorney argues that the public will be likely to believe that applicant's goods come from Milan and this belief will materially affect the public's decision to buy applicant's goods.

Turning first to the question of geographically deceptive misdescriptiveness, we agree with the Examining Attorney that applicant's mark MILANO and design is primarily geographically deceptively misdescriptive of applicant's goods. That is, purchasers would be likely to believe that western shirts sold under applicant's mark originated in or were somehow connected with Milan. While it appears that the term "Milano" has some surname

significance, the evidence of record demonstrates that the primary significance of the term is geographical.

Applicant has presented no evidence that "Milano" is a common surname. Moreover, we agree with the Examining Attorney that the pictorial representation of Italy in the drawing of the mark reinforces the geographic connotation. Most American consumers would certainly recognize the pictorial representation as Italy and along with the word MILANO would make an association with Milan. On the other hand, we are not convinced that most Americans would know that the star is in the location of Sorrento, rather than Milan. Thus, contrary to applicant, we do not find that the star negates any association with Milan. Also, in our minds, the lasso which surrounds the term MILANO and the pictorial representation of Italy does not detract from the geographic significance of the mark, but instead serves to convey that the goods are western in nature with a Milan origin or connection.

With respect to applicant's argument that customers will understand that MILANO in its mark refers to applicant and not the city of Milan, while customers who have some familiarity with applicant may well recognize this, our concern is not limited to these customers. Rather, we must concern ourselves with the purchasing public in general,

and purchasers who are not familiar with applicant would be free to make the association between the city of Milan and applicant's goods.

Turning then to the question of whether purchasers are likely to make a goods/place association between western shirts and Milan, we find that the Examining Attorney has submitted ample evidence to support such an association. In addition to the dictionary entry which indicates that Milan is a producer of clothing, the Examining Attorney submitted Nexis excerpts which demonstrate that, as applied to items of clothing, the primary significance of Milan is geographical given Milan's reputation as a center of fashion apparel. Examples are set forth below.

Spurring Milan's growth as a high-fashion hub are a handful of design houses such as Krizia, Versace, and Ferre, whose ties to Italian textile giants give them global reach.

(Business Week; July 20, 1987);

Although no strangers to fashion - the word "millinery" comes from "Milaner" - the Milanese have become a major power in the the international fashion world in just the last decade. Fashion generates more than \$10 billion in sales for Italy, almost half of which comes from exports. Even the French, vaunted masters of the fashion world, come here to buy much of their fabric, as do many of America's top designers.

Over the past decade, Milan has come to rival New York and Paris as one of the world's fashion centers.

(The Boston Globe; November 10, 1997); and

Okun is constantly at work with the company's customer base. And he travels all over to the world's fashion centers: Paris, London, Milan, attending all the important fashion shows and functions.

(Textile World; June 1996).

Further, the Examining Attorney made of record Nexis excerpts which demonstrate that western wear, in particular, debuts or premieres in Milan.

Every few years, as faithfully as a Yellowstone geyser, fashion goes cowboy crazy. Rodeo gaga. Boots, hats, beadwork, fringe - the icons of Western mythology suddenly start appearing on the likes of Madonna and Kate Moss and in places far, far from the Santa Fe Plaza or Mesquite Rodeo . . . Although this may be the biggest year for Westernalia since the roundup of '88, the specifics have changed just enough to require that we all go shopping. Far from "Urban Cowboy's" boot-scootin' flash or "Lonesome Dove's" dusty drovers, the latest spin on Western is rooted not in Laramie or Dodge, but in New York, Paris and Milan.

(Pittsburgh Post-Gazette; September 19, 1999);

Last summer, fashion magazines targeting both men and women touted "Vegas chic"-fringed and beaded jackets, skirts and pants, for instance . . . as the style to mimic. The industry's affinity for all things Western carried over into the fall and winter, when people attending the fashion shows in New York, Paris and Milan turned out in dark denim outfits accented with scrunched cowboy hats and

gleaming black boots.

Your father's suits, your son's cowboy boots, the animal skin rug in your den should form about the right inspirational mix for your fall fashion wardrobe, if the European shows have any say. In Milan, London and Paris, the world's top designers are going for menswear inspirations, American Western wear and animal prints in the clothes that will come here in many forms for fall and winter.

(The Boston Globe; March 23, 1992); and

"Here in Italy, I'm seeing a lot of big Western buckles, as well as exotic cowboy boots," said Julian by phone from a trend-watching trip to Milan. The revival of the Western look as fashion fare is hitting in the high-end designer category, says Julian. (The Times-Picayune; January 16, 2001).

This record establishes Milan's prominence as a center of fashion, including western wear, and the public would be likely to believe that applicant's shirts originate in or are somehow connected with Milan. The declaration of Mr. Cavender does not rebut this prima facie case. While traditional customers of western wear may be knowledgeable about its origins and may even prefer that it come from companies located in the southwest United States, our concern is not limited to such individuals. There is no question that western wear is sold to the buying public at large, and that from time to time, western styles are in fashion. Thus, the average purchaser would be likely to

believe, mistakenly, because of the association between Milan and clothing, that applicant's western shirts originate in or are somehow connected to Milan.

The final question then is whether the geographical misdescription created by applicant's mark has been shown to be material to the purchase of western shirts bearing the mark. We find that it has. The evidence put forth by the Examining Attorney demonstrates the fame of Milan as a center of fashion and its reputation for fine quality and famous designers. Thus, there is no question that a Milan connection would more appealing or desirable to prospective purchasers, and thus, this factor would be material to the decision to purchase such clothing.

Decision: The refusals to register under Section 2(e)(3) and 2(a) of the Trademark Act are affirmed.